

REMARKS

Status of Prosecution

Applicant filed the original application on June 20, 2003. The Examiner accepted a telephonic restriction, with traverse, and limited examination of the Application to claims 1-22. The Examiner thereafter mailed a first, non-final office action on February 23, 2004. This paper is in Reply to that office action. Applicant requests reconsideration and withdrawal of the objections and rejections raised in that office action.

Restriction Requirement

In Reply to the Examiner's earlier telephonic request under 35 U.S.C. §121, Applicant entered a telephonic election, with traverse, to prosecute the coupler as claimed in Group I, claims 1-22, a provisional election that Applicant now affirms.

In the Drawings

In amended Figure 2, element labeled 34d has been amended to be 32d.

Applicant also voluntarily has amended Figure 4 by adding reference numeral 52 appropriately.

Replacement formal drawing Figures 2 and 4 accompany this paper.

Examiner's General Objections and Rejections

Claims 1-22 are pending. In the Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. §102(b); rejected claims 4-22 under 35 U.S.C. §103(a), and objected to Figure 2 of the drawing. The Examiner gave no indication of allowability of any claim.

On page 3 of the Office Action the Examiner objected to drawing informalities. With this Reply Applicant has included formal replacement sheets.

On pages 4-5 the Examiner rejected claims 1-3 under 35 U.S.C. §102(b), stating that Applicant's invention is anticipated by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 ("Murray Patent"), arguments that Applicant respectfully traverses.

On pages 5-6 the Examiner rejected claim 4 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe ("Landgrebe Patent"), an argument that Applicant respectfully traverses.

On page 6 the Examiner rejected claim 5 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Landgrebe Patent, in further view of U.S. Patent No. 1,257, 536

issued to Schroeder on February 26, 1918 (“Schroeder Patent”), and that argument Applicant respectfully traverses.

On pages 6-7 the Examiner rejected claims 6-13 and 16-22 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent, arguments that Applicant respectfully traverses.

On page 9 the Examiner rejected claims 14-15 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent and in further view of the Landgrebe Patent, arguments that Applicant respectfully traverses.

Applicant respectfully urges, therefore, that the Examiner withdraw the objection in connection with Figure 2, and the rejections of the claims.

Telephone Interview

Applicant thanks the Examiner for the courtesy of a telephone interview on March 15, 2004. During the interview the Examiner suggested amending the claims to provide that the plug of the coupler is “unitary.” The Examiner also suggested amending the preamble of the claims to provide for a coupler attachable only to a hull of a boat or vessel.

The Applicant considered Examiner's helpful suggestions, but concluded that in view of the Application, when considered as a whole, including the specification and drawing figures, the amendments are unnecessary. In addition, in view of the prohibition against unnecessarily making narrowing amendments during prosecution imposed by the several decisions cumulatively referred to as the *Festo Decisions*, Applicant submits for the Examiner's consideration that when the Application is considered as whole, the suggested amendments are unnecessary.

Rejection Under 35 U.S.C. §102(b)

On pages 4-5 the Examiner rejected claims 1-3 under 35 U.S.C. §102(b), stating that Applicant's coupler is anticipated by the Murray Patent. In reply, Applicant submits that the coupler was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the Application in the United States. The claims, therefore, are allowable as originally filed because the cited reference does not anticipate Applicant's coupler.

Applicant's coupler as claimed in independent 1 is directed, among other things, to an apparatus that includes structural elements that differ from those claimed in the Examiner's primary reference, the Murray Patent. The structural elements of Applicant's coupler also cooperate differently than those claimed in the cited reference. Accordingly, the Examiner should withdraw the rejections of claims 1-3.

Specifically, as recited in claim 1, Applicant's coupler is variably positionable. The coupler includes a base having a flat planar surface on the lower side but is, nevertheless, mountable on a curved surface, a unique and novel contribution to the art, because means are provided for mounting the base on a curved surface. In one embodiment of the coupler, the means for the mounting the coupler on a curved surface is a plurality of ball washer assemblies. The structural elements comprising the ball washer assemblies are identified in the specification and claims. See Application, page 7, beginning at line 5, and claims 16-18, Application, page 14, beginning at line 10. Additionally, the coupler includes a structural element described as a tub. The tub cooperates with the base by being, as claimed, adjustably connectable to the base. A structural element described as a plug is provided. The plug cooperates with the tub by being repositionably attachable to the tub. In addition, the coupler includes a structural element identified as a neck. The neck is rotatably insertable in the plug. Further, the neck is formed for securing a shaft to the neck. A clevis mechanism, slidably and demountably engageable with the plug and the neck, also is included. See Application, page 12, lines 5-13.

The Murray Patent discloses neither the structure nor cooperation of structure of Applicant's coupler.

On page 4 of the Office Action, the Examiner provides marked up figures 4 and 5 extracted from the Murray Patent. The Examiner added reference numbers 100 and 200 to the marked up figures. The Examiner suggests that the Murray Patent discloses "...means (57) for mounting the base on a curved surface...." Applicant respectfully disagrees. Item 57 of the Murray Patent is not even mentioned in the specification of the Murray Patent. It appears that the lead line to item 57 is directed to a hole or bore. Neither the hole nor bore would provide the means for mounting the base on a curved surface provided by Applicant's coupler. Neither the hole nor bore comprise a plurality of ball washer assemblies as claimed by Applicant.

The Examiner also asserts on page 4 of the Office Action that the Murray Patent discloses "...a tub (100) adjustably connectable to the base...." The structural element marked by the Examiner in Figure 4 as item 100 is the same or similar to item 55 in Figure 5. But the specification of the Murray Patent identifies item 55 as "...an eyelet fitted on the end of the leg...." See Murray Patent, col. 5, ll. 12-14.

The Examiner then argues that the Murray Patent provides a structural element comparable to plug 72 of Applicant's coupler. The Examiner states that the Murray Patent discloses "...a plug (42, 71) repositionably attachable to the tub." Applicant respectfully disagrees. The Examiner seems to suggest that the plug of Applicant's coupler can be achieved by combining items 42 and 71 of the Murray Patent. But Marked-up Figure 4 on page 4 of the Office Action indicates that element 42 is a shaft or, in the words of the Murray Patent, a "leg portion 42...." See Murray Patent, col. 3, ll. 51. Item 71, however, collectively are "T-fitting 71 slides...that are extensions of "camel back hinges 40...." Neither alone nor in combination can elements 42 and/or 71 be said to repositionably attachable to a tub, as described and claimed in claim 1 of the Application, or can be said to provide for rotatable insertion of the neck as disclosed and claimed in the Application. See Application, Figure 2; and see Murray Patent, col. 4, ll. 11-14 and col. 3, ll. 48-49.

The Examiner also argues that the Murray Patent discloses a structural element akin to neck 74 of Applicant's coupler: the Examiner states that "...a neck (55) [is] rotatably insertable in the plug, wherein the neck is formed for securing a shaft 200 to the neck...." See Office Action, pages 4-5. Applicant respectfully disagrees. The Murray Patent discloses no structural element comparable to neck 74 of Applicant's coupler. The item that the Examiner identifies as "neck (55)" has already been identified by the Examiner as tub (100). In Applicant's coupler, neck 74 is rotatably insertable in plug 72. Accordingly, the element advanced by the Examiner as a "neck" is certainly not rotatably insertable in the plug.

The Examiner concludes the arguments about claim 1 of Applicant's coupler by the following assertion: "Note that while the Murray curved surface does not curve at its point of contact with element 40 [i.e., the camel back hinges noted above], it [presumably the 'curved surface'] does curve elsewhere and is thus a curved surface with the broadest reasonable interpretation of the claim language." See Office Action, page 5. Applicant is unclear as to the

Examiner's assertion. First, Applicant's coupler includes a base having a flat planar surface on the lower side that is, nevertheless, mountable on a curved surface. This unique and novel contribution to the art is both claimed and shown in Figures 3 and 4. Second, Applicant makes no claim that any element of the coupler has a curved surface. Third, the Examiner does not identify where the "elsewhere" is that shows that "it" curves.

As claimed, Applicant's coupler is Applicant's coupler is variably positionable. The device disclosed in the Murray Patent is not. At best, the Murray device can move in one plane. More specifically, using the terms of the Murray Patent, when T-fitting 71, as shown in Figure 5, is mounted on eyelet 55, the device can move only rotationally around a single point in an x-y axis. Applicant's coupler, however, is variably positionable.

In summary, the Murray Patent neither claims nor discloses, in combination, the coupler disclosed and claimed by Applicant.

For these structural reasons, and for the reasons articulated below, Applicant respectfully requests that the rejections of claims 1-3 under 35 U.S.C. §102(b) be withdrawn.

Discussion of Rejections under 35 U.S.C. §102

The fundamental teaching on the doctrine of anticipation was set forth by Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim.

In re William J. King at 231 USPQ 139 (emphasis added).

Further, as provided in MPEP §2131, for a reference to anticipate a claim, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). "Anticipation" is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (Emphasis added)

As discussed above, the Murray Patent does not disclose the identical structure and cooperation of structure as described in the Application.

Applicant, therefore, respectfully urges that the Murray Patent does not anticipate claims 1-3 of Applicant's coupler as claimed, and that those rejections be withdrawn.

First Rejection under 35 U.S.C. §103(a)

On pages 5-6 the Examiner rejected claim 4 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Landgrebe Patent.

Incorporating by reference all foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claim 4 is a dependent claim. Having overcome the rejections of independent claim 1, dependent claim 4 is allowable for at least the same reasons that support allowability of independent claim 1.

Further, as succinctly stated in the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....”

As provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Applicant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Although the Examiner argues on page 6 of the Office Action that “it would have been obvious to modify the coupler of Murray to include, (sic.) frustoconical recesses, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly,” the Examiner

points to no suggestion, no motivation, no teaching recited in either reference to support the argument.

Further, although the Examiner asserts that it would be permissible to modify the coupler by incorporating features of the Landgrebe Patent, Applicant respectfully submits it is improper to modify the coupler utilizing the reference. See MPEP §2143.01, the heading of which states that “The Proposed Modification Cannot change the Principle of Operation of a Reference.”

To combine the references in the manner sought by the Examiner is an application of impermissible hindsight in the analysis of Applicant’s novel coupler, and would require impermissible modification of the principles of operation of Applicant’s coupler.

Second Rejection under 35 U.S.C. §103(a)

On page 6 the Examiner rejected claim 5 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Landgrebe Patent, in further view of the Schroeder Patent, an argument Applicant respectfully traverses.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claim 5 also is a dependent claim. Having overcome the rejection of independent claim 1, dependent claim 5 is allowable for at least the same reasons that support allowability of independent claim 1. Although the Examiner argues on page 6 of the Office Action that “it would have been obvious...to adapt the means for mounting, as taught by Schroeder, to be used at each hole of the Murray means for mounting,” once again the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support such an argument.

Additionally, it seem evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor’s recommended use of the Schroeder device on first “a horizontal body portion,” and second, on a “vertical portion.” Unlike the variably positionable coupler claimed and disclosed by Applicant, to reverse the Schroeder device from a

horizontal to a vertical orientation, bolt 10 must be removed and reinserted “sideways.” See Figures 1 and 2.

Third Rejection under 35 U.S.C. §103(a)

On pages 6-7 the Examiner rejected claims 6-13 and 16-22 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent, arguments Applicant respectfully traverses.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 6-10 are dependent from independent claim 1. As Applicant already has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not anticipate Applicant’s coupler, dependent claims 6-10 are allowable for at least the same reasons that support allowability of independent claim 11.

The Examiner rejected independent claim 11 for obviousness. Applicant respectfully traverses that rejection.

Independent claim 11 claims a boom-swivel device 68 that is detachably fixable to base 12. The claims dependent from independent claim 11, and the specification of the Application, show that boom-swivel device 68 includes at least one tub 70 (see claim 19), a plug 72 (see claim 20), and a neck 74 (see claim 21). Applicant incorporates by reference all arguments made in this paper in connection with those elements of the coupler, and submits that Applicant has overcome the rejection of the Examiner. As to the rejection for obviousness the Schroeder Patent, Applicant has already overcome any application of that reference to Applicant’s coupler, and further submits for the Examiner’s consideration that there is neither a suggestion or motivation recited in either reference to combine elements in the novel manner of Applicant’s coupler, nor any teaching of all the claim limitations. Accordingly although the Examiner argues on page 8 of the Office Action that “it would have been obvious...to adapt the washer assembly, as taught by Schroeder, to be combined with each hole of the Murray means for mounting...,”

the Examiner points to no suggestion, motivation, or teaching recited in either reference to support the argument.

In addition, Schroeder offers no teaching or suggestion that the Schroeder device is mountable on a curved surface. Attempting to combine the elements of the Murray Patent with the elements of the Schroeder Patent would result in an assembly that certainly would not be stationary on a curved surface, and could rotate only in one plane. Contrary to the Examiner's argument, the Schroeder ball washer assembly is not "beneficial for mounting components in a variety of positions," but rather only on a horizontal or planar position. See Office Action, page 8.

Claims 12-13 and 16-22 are dependent from independent claim 11. As Applicant has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 16-22 are allowable for at least the same reasons that support allowability of independent claim 11.

Fourth Rejection under 35 U.S.C. §103(a)

On page 9 the Examiner rejected claims 14-15 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent and in further view of the Landgrebe Patent, arguments Applicant respectfully traverses.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 14-15 depend from independent claim 11. As Applicant already has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 14-15 are allowable for at least the same reasons that support allowability of independent claim 11.

Nothing in any of the cited references suggests or teaches the modifications or combinations argued by the Examiner.

Teaching Applicable to Rejections Under 35 U.S.C. §103

To combine the references in the manner sought by the Examiner is an application of impermissible hindsight in the analysis of Applicant's novel coupler, and would require impermissible modification of the principles of operation of Applicant's coupler.

For all rejections by the Examiner under 35 U.S.C. §103, Applicant repeats that the MPEP provides that to establish a *prima facie* case of obviousness the Examiner must show that the cited references show (1) a suggestion or motivation to modify the cited reference or to combine the teachings; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference "must expressly or impliedly suggest the claimed invention...."

As Applicant has shown, none of those elements of proof establishes a *prima facie* instance of obviousness.

The MPEP summarizes the progression of requirements imposed on prosecution practice by decisions of the Court of Appeals, Federal Circuit, a progression of decisions beginning with *In re Fine* and extending through *In re Fitch*. Briefly, the Court held in *In re Fine* that "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so...." *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Further, the same prior art must "provide one of ordinary skill in the art the motivation to make the...modifications...." *In re Fine*, at 1944.

The Federal Circuit has held that the requirement that any modification suggested by the Examiner is not obvious unless the prior art suggests the desirability for the modification. *In re Fitch*, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (emphasis added).

Recent Federal Circuit decisions have amplified the Examiner's burden of proof and standards for establishing obviousness under §103.

The first decision is *In re Debiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); the second is *Ecolochem, Inc. v. Southern California Edison Company*, Fed. Cir. No. 99-1043, September 7, 2000; the third is *In re Sang-su Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434-1435 (CAFC, 2002).

These cases remind us that obviousness must be considered solely “at the time the invention was made.” *In re Debiczak*, 50 USPQ2d 1614 at 1617, citing 35 U.S.C. §103. As the Federal Circuit reminded that the goal is not to “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.” *In re Debiczak*, 50 USPQ2d 1614 at 1617.

The Examiner also must show evidence to support the assertion of a suggestion, teaching, or motivation. Absent such proof, it is inappropriate to “make the inventor’s disclosure a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *In re Debiczak*, 50 USPQ2d 1614 at 1617 (emphasis added).

Conclusions

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-22.

The remaining references cited by the Examiner, but not relied on for the rejection of claims 1-22, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

In conclusion, Applicant respectfully asserts that this Reply is complete as contemplated in 37 CFR §1.111, that claims are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully requests an early notice of allowance. The Examiner is requested to call the undersigned at (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted for Applicant by:

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APPENDIX

Replacement formal drawing sheets follow this page.